



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,358	05/02/2001	Yukihiko Nansho	01309.00012	3942

22907 7590 07/15/2003

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER
----------

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,358

Applicant(s)

NANSHO, YUKIHIKO

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's "Amendment" filed on May 2, 2003 has been considered with the following effect.

Applicant cancelled claim 1-4, and 6-7 and added new claims 9-16. Claims 9-16 remain pending and an action on the merits of these claims follows.

### ***Response to Arguments***

Applicant's arguments filed on May 2, 2003 have been fully considered but they are not persuasive.

Applicant remarks that "Mistr does not require a manufacturer to present specification requirements for constructing elements of a final commodity, such as the required material or processing. Thus, the system of Mistr has no means for registering the specification requirements disclosed by the manufacturer. Moreover, Mistr does not provide a system wherein the registered specification requirements are provided to a material supplier or a processor and a material supplier or the processing inputs information on material or processing, based on the registered specification requirements."

The Examiner notes that Mistr discloses the manufacturer (buyer) to present the specification requirements. In col. 4, lines 15-16, the processor receives the user's request. In col. 7, lines 52-62, the buyer (manufacturer) request a specific amount of suppliable material and the request is transmitted to the provider of the material

Art Unit: 3625

(material supplier). Such user request that is received by the provider is considered the specific requirements that are presented and registered.

The Applicant remarks that "Mistr has no concept of delivery time of material/processing and a commodity finally selected by a demander"

The Examiner notes that Mistr does disclose the timely delivery of the material and a commodity selected by a demander. In claim 9, Mistr disclose the timely delivery of the material. Furthermore in col. 2, lines 62, Mistr discloses the reliability of the delivery of the material.

The Applicant remarks that "the article is completely unrelated to the delivery of natural resources as taught in Mistr thus their combination can only be based on impermissible hindsight afforded the instant claims. In addition, there is simply no reason one skilled in the art would have substituted thinned-out wood for the electricity described in Mistr".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,794,212 to Mistr.** Mistr discloses a processing system, an output unit and output method comprising: receiving and storing information from a material supplier regarding available material based on specification requirements and date of delivery of material, the specification requirements being presented by a manufacturer who supplies the commodity to the demander (col. 3, lines 3, lines 16-22; col. 4, lines 11-28; col. 5, lines 43-47; col. col. 7, lines 52-56; col. 13, lines 1-4); storing and receiving information on available processing corresponding to the specification requirements and time of delivery of the processing (col. 3, lines 16-22; col. 5, lines 43-47; col. 13, lines 1-4); inputting information on desired material and desired processing (col. 3, lines 3, lines 16-22; col. 4, lines 11-28; col. 5, lines 43-47; col. col. 7, lines 52-56; col. 13, lines 1-4); and outputting information the available material and the available processing corresponding to the input information on the desired material and the desired processing, and date of delivery of a commodity (col. 3, lines 3, lines 16-22; col. 4, lines 11-28; col. 5, lines 43-47; col. col. 7, lines 52-56; col. 13, lines 1-4). Mistr does not explicitly disclose commodity, however, it discloses energy which is a commodity. It would have been obvious to one of ordinary skill in the

Art Unit: 3625

art at the time of the invention was made to modify the system, method and unit of Mistr since the examiner takes Official Notice of the equivalence of energy and commodity for their use in Mistr and the selection of any of these known equivalents to purchasing would be within the level of ordinary skill in the art.

**Claims 10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,794,212 to Mistr in view of the article "Earth-friendly good".** Mistr substantially discloses the claimed invention, however, it does not disclose the thinned-out woods. However, Mistr discloses that his commodity is energy which is from natural resources which is reduced from raw materials for consumer utilization. Mistr does not disclose that his commodity is thinned-out wood. The article "Earth-friendly good" teaches a commodity, specifically, thinned-out wood. Such thinned-out wood is like or similar to energy, a natural resource that is reduced from raw materials for consumer useable product in a manner similar to the commodity of Mistr. (See whole article)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, method, and unit of Mistr, to include the thinned-out woods, in order to provide an efficient and reliable movement of a commodity of materials between the parties (col.3, lines 42-45). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system and method and unit of Mistr, to include the thinned-out woods, in order to provide an efficient system and transmission of commodity materials by providing constraint mitigation and unified services (Mistr col. 10, lines 41-43).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

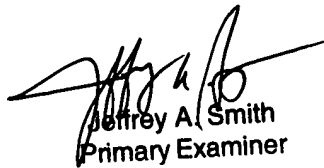
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot  
July 14, 2003



Jeffrey A. Smith  
Primary Examiner